

REMARKS

In response to the Office Action dated May 24, 2002, the following arguments are presented. Claims 2-23 remain in the case. In light of the arguments and evidence set forth herein, the Applicants respectfully request reexamination and reconsideration of the application.

The Office Action rejected claims 2-23 under 35 U.S.C. § 103(a) as being unpatentable over Maggioncalda et al. (U.S. Patent No. 6,012,044) in view of Rosenberg (U.S. Patent No. 6,061,004).

The Applicants respectfully traverse this rejection based on the arguments below.

The Office Action contended that Maggioncalda et al. disclose all elements of the Applicants' claimed invention except for the interface tool having drop-down menus. However, the Office Action further stated that it is common practice to have drop-down menus in an interface tool (such as in Rosenberg). Thus, the Office Action maintained that it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a drop-down menu as an interface tool to help and visibly facilitate user interaction with a constrained set of decision variables.

In response, the Applicants respectfully disagree with these statements. The Applicants' maintain that the reference of Maggioncalda et al. is not prior art in relation to Applicants' claimed invention.

In general, as set forth in 37 CFR § 1.131, if a reference does not claim the same patentable invention as the applicant, and the applicant reduced the invention to practice in the United States prior to the effective date of the reference, then the reference is not prior art in relation to the applicant's invention. The Applicants

respectfully maintain that these circumstances exist in the subject case.

First, Maggioncalda et al. do not claim the same patentable invention as the Applicants claimed invention. In accordance with 37 C.F.R. § 1.601(n), the "same patentable invention" is one where an applicant's invention is anticipated under 35 U.S.C. § 102 or obvious under 35 U.S.C. § 103. The Applicants' claimed invention is not anticipated by Maggioncalda et al. because Maggioncalda et al. lack at least one claimed element of the Applicants' claimed invention. In particular, Maggioncalda et al. lack the Applicants' claimed element of transmitting associated data (which is a subset of all available data) from a server to the client.

The Applicants' claimed invention also is not obvious under 35 U.S.C. § 103 in view of the Maggioncalda et al. reference. A prima facie showing of obviousness must consider all of the claimed elements of an applicant's invention, especially when these claimed elements are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie showing of obviousness has been made. The Federal Circuit Court has held that it was an error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Moreover, if the prior art references do not disclose, suggest or provide any motivation for at least one claimed element of an applicant's invention then a prima facie case of obviousness has not been established (MPEP § 2142).

Independent claims 2, 7 and 19 of the Applicants' invention include transmitting associated data (which is a subset of all available data) from a server to the client. In contrast, Maggioncalda et al. transmits all data contained on the server to the client computer. Moreover, Maggioncalda et al. fail to appreciate the advantages of transmitting only a subset of all available data. Specifically, transmitting only a portion of all available data reduces transmission and download times and decreases storage space requirements on the remote client.

Accordingly, the Applicants respectfully contend that independent claims 2, 7 and 19 are nonobvious over the Maggioncalda et al. reference. Further, claims 3-6 depend from independent claim 2, claims 8-18 depend from independent claim 7, and claims 20-23 depend from independent claim 19. It follows, therefore, that these dependent claims are also nonobvious over the Maggioncalda et al. reference (MPEP § 2143.03).

Thus, the Applicants' claimed invention is not the "same patentable invention" as Maggioncalda et al. under 37 C.F.R. § 1.601(n) because the claimed invention is neither anticipated by Maggioncalda et al. under 35 U.S.C. § 102 nor obvious in view of Maggioncalda et al. under 35 U.S.C. § 103. Accordingly, the Maggioncalda et al. reference does not claim the same patentable invention as the Applicants' claimed invention.

Second, in order to prove that the Maggioncalda et al. reference is not prior art in relation to the Applicants' claimed invention, it also must be shown that the Applicants reduced the invention to practice in the United States prior to the effective date of the Maggioncalda et al. reference. The effective date of Maggioncalda et al. is the filing date of May 25, 1999. Because Maggioncalda et al. is a continuation of U.S. Patent 5,918,217, however, in certain situations the effective date of Maggioncalda et al. may be the filing date of the parent application, or December 10, 1997.

The Applicants' reduction to practice occurred before the earliest effective date of December 10, 1997 of the Maggioncalda et al. reference. The Applicants reduced the invention to practice at Microsoft Corporation in Redmond, Washington prior to December 10, 1997. Evidence of this was provided in a previous response by a declaration of one of the Applicants and an exhibit. The declaration stated that reduction to practice of the claimed invention occurred prior to December 10, 1997, and the exhibit supported this statement. The exhibit, designated Exhibit "A", presented an e-mail dated September 19, 1996 sent by one of the inventors to other members of a development team indicating that the first release build of a software application entitled

"LoanCalc" was available at an internal Microsoft directory. As stated by the inventor in the declaration, the first release build of the LoanCalc software application referred to in the e-mail contained the Applicants' claimed invention.

The Office Action maintained that Exhibit "A" was insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Maggioncalda et al. reference. The Office Action asserted that the e-mail in Exhibit "A" is not evidence that provides a showing of the facts in character and weight, and thus is not considered to fully embody the Applicants' invention as described and claimed. Additionally, the Office Action stated that the Examiner had no means of verifying that the build of LoanCalc referred to in the e-mail actually contains the claimed programs. The Office Action asserted that with only the build file name and the path disclosed by the e-mail, the Examiner cannot verify that the LoanCalc programs were functional.

The Applicants respectfully disagree with these statements. However, in an effort to further the prosecution of this application, the Applicants have submitted herewith additional evidence. It is the Applicants' position that the additional evidence presented herein is an even greater showing of the facts in character and weight to establish reduction to practice prior to the effective date of the Maggioncalda et al. reference.

In particular, a declaration signed by one of the inventors, Mark E. Hickling, declares that reduction to practice of the Applicants' claimed invention occurred prior to December 10, 1997. Exhibits "B" and "C" support this statement. Specifically, Exhibit "B" includes a notebook entry dated March 27, 1995, of one of the Applicants containing a drawing of the claimed invention. The drawing illustrates the query grid and the adjustable interface option (in the form of sliders) displayed on a client display device for adjusting associated data associated fields (such as pricing data).

Exhibit "C" includes a revised draft of a user's guide to using the software

application entitled "LoanCalc". This revised draft is dated August 20, 1996. Specifically, the revised draft of the user's guide instructed a user how to enter data into at least one field of a query grid. Data associated with the field could then be displayed on a client display device. The data could be adjusted using an adjustable interface option displayed on the client display device. In particular, pricing data could be adjusted by a user through a graphical user interface on the client computer.

Exhibits A", "B" and "C" along with the declarations from two of the inventors proves that reduction to practice occurred at least before December 10, 1997. The dates of the exhibits are at least over one year before any of the effective dates of the Maggioncalda et al. reference. Accordingly, the Applicants respectfully submit that they have provided a showing of facts sufficient in both character and weight to establish reduction to practice in the United States prior to any of the effective dates of the Maggioncalda et al. reference.

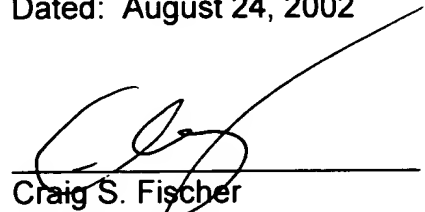
The Applicants have shown that Maggioncalda et al. do not claim the same patentable invention as the Applicants' claimed invention and that the Applicants reduced the invention to practice in the United States prior to any effective dates of the Maggioncalda et al. reference. Consequently, the Applicants respectfully submit that the Maggioncalda et al. reference is not prior art in relation to the Applicants' claimed invention. Accordingly, the Applicants maintain that their claimed invention is patentable in view of Maggioncalda et al. under 35 U.S.C. § 103(a).

In view of the unavailability of Maggioncalda et al. as prior art, the Applicants respectfully submit that the rejection of claims 2-23 under 35 U.S.C. § 103(a) as being unpatentable over Maggioncalda et al. has been overcome. The Applicants, therefore, respectfully requests reexamination, reconsideration and withdrawal of the rejection of claims 2-23 under 35 U.S.C. § 103(a).

In view of the arguments set forth above, the Applicants respectfully submit that pending claims 2-23 of the subject application are in immediate condition for allowance.

The Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. Additionally, in an effort to expedite and further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (805) 278-8855 if the Examiner has any comments, questions or concerns.

Respectfully submitted,
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